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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,157	06/08/2001	Terry Michael Bleizeffer	RSW920000172US1	1012

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Gerald R. Woods
IBM Corporation
T8/503
PO Box 12195
Research Triangle Park, NC 27709

EXAMINER	
WINTER, JOHN M	

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/877,157	BLEIZEFFER ET AL.	
	Examiner	Art Unit	
	John M Winter	3621	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 July 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

STATUS

Claims 1-24 have been examined.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Response to Arguments

The Applicants arguments filed on July 7, 2004 have been fully considered.

The Applicant states that claims previously rejected under 35 USC 101 are patentable subject matter.

The Examiner responds that as an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson,* 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

> The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.,* the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma.* However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application claims 1 and 12 only recites an abstract idea. In claims 1 and 12 the applicant claims a method for creating policy groups, moving a data element between groups and generating a privacy policy based upon the policy group. This process might be performed without the aid of any technology and therefore the claimed method is not within the technological arts.

The Applicant states that the claims of the present invention are directed towards a different purpose and are not obvious in view of the prior art.

Examiner responds that as per *Ex parte Clapp*, 227 USPQ 972 (Bd Pat App & Int) "To support conclusion that claimed combination is directed to obvious subject matter, the references must either expressly or impliedly suggest claimed combination or the examiner must present a convincing line of reasoning as to why artisan would have found claimed invention to have been obvious in light of the references teachings.", the Examiner states the reference deals with the generalized problem of creating privacy policies and therefore would be obvious to a person of ordinary skill in the art.

The applicant states that the Moriconi et al refernce does not address the problem of creating a "privacy policy"

The Examiner responds that Moriconi et al states "It is the further object of the present invention to provide a system that combines a centrally managed policy database with distributed authorization (access control) services that enforce the policy for all applicationsacross the organization" (Column 3 ,lines 63-67), while the Examiner notes the difference between "security" and "privacy" it is also noted that a system that enforces an **authorization policy** by definition is also enforcing a privacy policy. Therefore by establishing a hierarchy of permissions to access data Moriconi et al in effect creates a privacy policy.
See following rejection.

Claim Rejections - 35 USC §101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In claims 1 and 12 the applicant claims a method for creating policy groups, moving a data element between groups and generating a privacy policy based upon the policy group. This process might be performed without the aid of any technology and therefore the claimed method is not within the technological arts.

All that is necessary to make a sequence of operational steps in a statutory process within 35 U.S.C. 101 is that it be in the technological arts so as to be in concordance with the Constitutional purpose to promote the progress of "useful arts" *In re Musgrave*, 431 F.2d 882 167 USPQ 280 (CCPA 1970)

A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. *See AT&T v. Excel Communications Inc.*, 172 F3d at 1358, 50 USPQ2dat 1452.

Claims 2-11 and 13-22 are dependant on rejected claim 1 and 12 respectively , and are rejected for at least the same reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1- 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moriconi et al (US Patent 6,158,010) in view of Abraham et al. (WO 98/40987).

As per claim 1,
Moriconi et al ('010) discloses a method for creating a privacy policy, comprising:
moving a data element to the policy group;(Figure 9)
generating a privacy policy based on the policy group.(Figure 4)
Moriconi et al ('010) does not explicitly disclose creating a policy group, Abraham et al. ('987) discloses creating a policy group.(Abstract) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Moriconi et al ('010)'s method with the Abraham et al. ('987)'s method in order to secure management of a computer network

As per claim 2,
Moriconi et al ('010) discloses the method of claim 1,
wherein the data element is a predefined data element.(Column 6, lines 20-26)

As per claim 3,
Moriconi et al ('010) discloses the method of claim 1,
wherein the data element comprises at least one sub-element.(Column 6, lines 46-51)

As per claim 4,
Moriconi et al ('010) discloses the method of claim 1, further comprising:
updating a policy-wide property; and generating the privacy policy based on the policy-wide property.(Column 5, lines 48-55)

As per claim 5,
Moriconi et al ('010) discloses the method of claim 1,
wherein the step of generating a privacy policy comprises generating a human readable version of the policy.(Column 9, lines 45-50 – Examiner notes that although Moriconi et al does not specifically disclose "generating a human readable version of the policy" it would be obvious that if the policy is manipulated via a GUI it would be readable to the user.)

As per claim 6,
Moriconi et al ('010) discloses the method of claim 5,
Official Notice is taken that "hypertext markup language version of the policy" is common and well known in prior art in reference to policy management. It would have been obvious to one having ordinary skill in the art at the time the invention was made to render the policy in HTML format in order to provide a format that is universally viewable across a wide variety of computer platforms and operating systems.

As per claim 7,
Moriconi et al ('010) discloses the method of claim 1,
Official Notice is taken that "generating an extensible markup language version of the policy" is common and well known in prior art in reference to policy management. It would have been obvious to one having ordinary skill in the art at the time the invention was made to render the policy in XML format in order to provide a format that is universally viewable across a wide variety of computer platforms and operating systems.

As per claim 8,
Moriconi et al ('010) discloses the method of claim 1,
wherein the step of generating a privacy policy comprises generating a compact policy.(Figure 4 – note element 436 optimizer)

As per claim 9,
Moriconi et al ('010) discloses the method of claim 1,
wherein the step of generating a privacy policy comprises generating a policy statement corresponding to the policy group.(Figure 4)

As per claim 10,
Moriconi et al ('010) discloses the method of claim 9,
wherein the step of generating a privacy policy further comprises generating a table of policy elements, wherein a policy element in the table of policy elements corresponds to the policy statement.(Column 4, lines 34-37—the rules [i.e. elements] are stored in a database [i.e. table])

As per claim 11,
Moriconi et al ('010) discloses the method of claim 1,further comprising:
identifying an error in the privacy policy;(Column 11, lines 44-46 – Although Moricini does not specifically disclose generating an error statement describing the error he does disclose generating a log file, it is well known within modern computing systems to automate the generation of error reports from log files)

As per claim 12,
Moriconi et al ('010) discloses an apparatus for creating a privacy policy, comprising:
movement means for moving a data element to the policy group;(Figure 9)
generation means for generating a privacy policy based on the policy group.(Figure 4)

Moriconi et al ('010) does not explicitly disclose creation means for creating a policy group, Abraham et al. ('987) discloses creation means for creating a policy group.(Abstract) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Moriconi et al ('010)'s apparatus with the Abraham et al. ('987)'s apparatus in order to secure management of a computer network

As per claim 13,
Moriconi et al ('010) discloses the apparatus of claim 12,
wherein the data element is a predefined data element.(Column 6, lines 20-26)

As per claim 14,
Moriconi et al ('010) discloses the the apparatus of claim 12,
wherein the data element comprises at least one sub-element. (Column 6, lines 46-51)

As per claim 15,
Moriconi et al ('010) discloses the apparatus of claim 12, further comprising:
means for updating a policy-wide property; and means for generating the privacy policy based on the policy-wide property.(Column 5, lines 48-55)

As per claim 16,
Moriconi et al ('010) discloses the apparatus of claim 12,
wherein the generation means comprises means for generating a human readable version of the policy.(Column 9, lines 45-50 – Examiner notes that although Moriconi et al does not specifically disclose "generating a human readable version of the policy" it would be obvious that if the policy is manipulated via a GUI it would be readable to the user.)

As per claim 17
Moriconi et al ('010) discloses the apparatus of claim 16,
Official Notice is taken that "hypertext markup language version of the policy" is common and well known in prior art in reference to policy management. It would have been obvious to one having ordinary skill in the art at the time the invention was made to render the policy in HTML format in order to provide a format that is universally viewable across a wide variety of computer platforms and operating systems.

As per claim 18
Moriconi et al ('010) discloses the apparatus of claim 19,
Official Notice is taken that "generating an extensible markup language version of the policy" is common and well known in prior art in reference to policy management. It would have been obvious to one having ordinary skill in the art at the time the invention was made to render the policy in XML format in order to provide a format that is universally viewable across a wide variety of computer platforms and operating systems.

As per claim 19,

Moriconi et al ('010) discloses the apparatus of claim 12,
wherein the generation means comprises means for generating a compact policy.(Figure 4 – note element 436 optimizer)

As per claim 20,
Moriconi et al ('010) discloses the apparatus of claim 12,
wherein the generation means comprises means for generating a policy statement corresponding to the policy group.(Figure 4)

As per claim 21
Moriconi et al ('010) discloses the apparatus of claim 20,
wherein the generation means further comprises means for generating a table of policy elements, wherein a policy element in the table of policy elements corresponds to the policy statement.(Column 4, lines 34-37—the rules [i.e. elements] are stored in a database [i.e. table])

As per claim 22,
Moriconi et al ('010) discloses the apparatus of claim 12, further comprising: means for identifying an error in the privacy policy;(Column 11, lines 44-46 – Although Moricini does not specifically disclose generating an error statement describing the error he does disclose generating a log file, it is well known within modern computing systems to automate the generation of error reports from log files)

As per claim 23,
Moriconi et al ('010) discloses an interface for creating a privacy policy, comprising:
a first portion for displaying predefined data elements;(Column 9, lines 45-50)
a second portion for displaying groups of data elements, wherein a group of data elements shares at least one common property;(Figure 4)
Moriconi et al ('010) does not explicitly disclose a third portion for displaying a privacy policy generated from the groups of data elements, Abraham et al. ('987) discloses a third portion for displaying a privacy policy generated from the groups of data elements.(Abstract) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Moriconi et al ('010)'s method with the Abraham et al. ('987)'s method in order to secure management of a computer network

As per claim 24,
Moriconi et al ('010) discloses a computer program product, in a computer readable medium, for creating a privacy policy, comprising:
instructions for moving a data element to the policy group(Figure 9)
instructions for generating a privacy policy based on the policy group.(Figure 4)
Moriconi et al ('010) does not explicitly disclose instructions for creating a policy group, Abraham et al. ('987) discloses instructions for creating a policy group.(Abstract) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Moriconi et al ('010)'s method with the Abraham et al. ('987)'s method in order to secure management of a computer network

Conclusion

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW
September 7, 2004